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| 10/780,717 | 02/19/2004 | Francis Pinault | Q79641 | 3210 |
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| SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037 | | | RAMAKRISHNAIAH, MELUR | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | |
|------------------------------|---|---|
| Office Action Summary | Application No. 10/780,717 | Applicant(s) PINault, FRANCIS |
| | Examiner Melur Ramakrishnaiah | Art Unit 2614 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If no period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(o).

Status

- 1) Responsive to communication(s) filed on 19 February 2004.
 2a) This action is FINAL. 2b) This action is non-final.
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-25 is/are pending in the application.
 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
 5) Claim(s) _____ is/are allowed.
 6) Claim(s) 1-25 is/are rejected.
 7) Claim(s) _____ is/are objected to.
 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>2-19-2004</u> | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 1 recites among other things: on receipt of a call request to a user known as called user from a user known as calling user, to access said memory in order to extract the lists of identifiers of terminals which are associated with the identifiers of said calling and called users, and then to determine, from these extracted lists, a calling and called terminal which is likely to establish a call between them which satisfies the call request of the calling user, in accordance with at least one availability criterion. This claim limitation requires that calling user initiates a call to a called user through a switch or server which determines identifiers of calling and called user terminals and then select the best terminals to satisfy call request in accordance with at least one availability criterion. This presupposes two stage process: first phase is used to first find out identifies of the calling and called terminals to satisfy some availability criterion for the call; second phase server/or switch after determining identifiers of the calling and called terminals which satisfy the availability criterion for the call, should initiate call to calling terminal and called terminal identified in the first phase and connect the call.

Applicant's specification does not disclose this or it is not clear from applicant's disclosure how this is accomplished.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3, 6-7, 21-22, 25 are rejected under 35 U.S.C 102(b) as being anticipated by Ono et al. (JP07-264298, hereinafter Ono).

Regarding claim 1, Ono discloses a device (Drawing 4) for the management of communication between communication terminals (for example: video telephone system, facsimile equipment, an electronic mail, voice mail etc), characterized in that includes a memory (2, Drawing 4) capable of storing identifiers of users in correspondence with lists of at least one communication terminal identifier and possessing means (not shown) arranged, on receipt of a call request to a user known as called user from a user known as calling user, to access memory (2, Drawing 4) in order to extract the lists of identifiers of terminals which are associated with the identifiers of the calling and called users, and then to determine, from these identified lists, a calling and a called terminal which is likely to establish a call between them which satisfies the call request of the calling user, in accordance with at least one availability criterion (Drawings: 4-7; abstract; paragraphs: 0007 - 0015).

Regarding claims 2-3, 6-7, 21-22, 25, Ono further discloses the following: the processing means (not shown) are arranged to determine the calling and called terminals, as well as communication medium (reads on plural network interfaces: see abstract) which is suitable for the calling and called terminals characterized in that determined medium is that capable of providing for the transmission of the greatest number of different types of data, communication which satisfies the request should take place via at least one communication network presenting a state of availability of resources, where the processing means are capable of effecting their determination in accordance with the state of availability of the communication network resources, the processing means are arranged to effect their determination in accordance with at least one other criterion, known as auxiliary criterion (such as the availability of video telephone, or facsimile, or voice mail, etc), processing means, after determination of the calling and called terminals, to order the establishment of the call between the calling and called terminals, the processing means are arranged to order the establishment automatically, it includes at least one management device (reads on database 2 management, Drawing 4) in accordance with claim 1 Drawings: 4-7; abstract; paragraphs: 0007 - 0015).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 4-5, 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono in view of McKinnon et al. (US 2003/0135624, filed 12-27-2001, hereinafter McKinnon).

Ono differs from claim 4 in that he does not specifically teach: processing means are suitable of effecting their determination with the state of availability of the calling and called terminals.

However, McKinnon discloses dynamic presence management which teaches the following: processing means are suitable of effecting their determination with the state of availability of the calling and called terminals (abstract; paragraphs: 0029, 0031).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ono's system to provide for the following: processing means are suitable of effecting their determination with the state of availability of the calling and called terminals as this arrangement would facilitate to connect the call depending upon availability of users to receive communications, thus facilitating effective communications as taught by McKinnon.

Regarding claim 5, Ono teaches the following: memory (2, Drawing 4) is suitable for storing the communication terminal identifiers (paragraph: 0010).

Ono differs from claims 8-9 in that he does not specifically teach: the processing means are capable of effecting their determination in accordance with the state of accessibility of users, where accessibility constitutes auxiliary criterion, memory capable of storing the user identifiers in correspondence with their state of accessibility.

However, McKinnon teaches the following: the processing means are capable of effecting their determination in accordance with the state of accessibility of users, where accessibility constitutes auxiliary criterion, memory capable of storing the user identifiers in correspondence with their state of accessibility (abstract; paragraphs: 0029, 0031).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ono's system to provide for the following: the processing means are capable of effecting their determination in accordance with the state of accessibility of users, where accessibility constitutes auxiliary criterion, memory capable of storing the user identifiers in correspondence with their state of accessibility as this arrangement would provide means for effecting optimal communication between communication parties as taught by McKinnon.

7. Claims 10-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono in view of Horvitz (WO02/075495 A2).

Ono differs from claims 10-12 in that he does not specifically teach the following: processing means are capable of effecting their determination in accordance with preferences of terminal use of the calling and/or called users, where the preferences of use constitute an auxiliary criterion, memory is capable of storing the user identifiers in correspondence with a terminal use preferences, at least one of the users is associated with a company which has a defined policy for the use of terminals/or media, and that the processing module are capable of effecting their determination in accordance with the policy of use, where the policy of use, where the policy of use constitutes an auxiliary condition.

However, Horvitz discloses system and method for identifying and establishing preferred modalities or channels for communications based on participants' preferences and contexts which teaches the following: processing means are capable of effecting their determination in accordance with preferences of terminal use of the calling and/or called users, where the preferences of use constitute an auxiliary criterion, memory is capable of storing the user identifiers in correspondence with a terminal use preferences, at least one of the users is associated with a company which has a defined policy for the use of terminals/or media, and that the processing module are capable of effecting their determination in accordance with the policy of use, where the policy of use, where the policy of use constitutes an auxiliary condition (page 24, line 11 – page 26, line 5; figs. 4, 8-9; page 37, line 22 – page 39, line 25).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ono's system to provide for the following: processing means are capable of effecting their determination in accordance with preferences of terminal use of the calling and/or called users, where the preferences of use constitute an auxiliary criterion, memory is capable of storing the user identifiers in correspondence with a terminal use preferences, at least one of the users is associated with a company which has a defined policy for the use of terminals/or media, and that the processing module are capable of effecting their determination in accordance with the policy of use, where the policy of use, where the policy of use constitutes an auxiliary condition as this arrangement would provide means for effecting optimal communication between communication parties as taught by Horvitiz.

8. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono in view of Weik (US PAT: 7,024,480, filed 11-2-2001).

Ono differs from claims 13-14 in that he does not specifically teach the following: processing means are capable of effecting their determination in accordance with the level of quality associated with the calling ands/or called users, where the quality levels constitute an auxiliary criterion, memory is capable of storing the user identifiers in correspondence with a information representing communication quality.

However, Weik discloses method, devices and program modules for data transmission with assured quality of service which teaches the following: processing means (reads on gate way) are capable of effecting their determination in accordance with the level of quality associated with the calling ands/or called users, where the quality levels constitute an auxiliary criterion, memory is capable of storing the user identifiers in correspondence with a information representing communication quality (col. 2 lines 51-63; col. 10 lines 17-51).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ono's system to provide for the following: processing means are capable of effecting their determination in accordance with the level of quality associated with the calling ands/or called users, where the quality levels constitute an auxiliary criterion, memory is capable of storing the user identifiers in correspondence with a information representing communication quality as this arrangement would facilitate to transmit data with required quality of service between communication terminals as taught by Weik.

9. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono in view of Gessel (US PAT: 5,790,647).

Ono differs from claims 15-16 in that he does not specifically teach: processing means are capable of effecting their communication in accordance with the hierarchical level of the calling and/or called users, where the hierarchical level constitutes an auxiliary criterion, memory is capable of storing the user identifiers in correspondence with information representing a hierarchical level in the company.

However, Gesel discloses subscriber feature services in a telephone communication system which teaches the following: processing means (reads on telephone exchange) are capable of effecting their communication in accordance with the hierarchical level of the calling and/or called users, where the hierarchical level constitutes an auxiliary criterion, memory is capable of storing the user identifiers in correspondence with information representing a hierarchical level in the company (col. 3 lines 48-61).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ono's system to provide for the following: processing means are capable of effecting their communication in accordance with the hierarchical level of the calling and/or called users, where the hierarchical level constitutes an auxiliary criterion, memory is capable of storing the user identifiers in correspondence with information representing a hierarchical level in the company as this arrangement would provide means for automatically effecting desired call handling features depending upon the importance of the call as taught by Gessel.

10. Claims 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono in view of Thornton et al. (US PAT: 6,363,065, hereinafter Thornton).

Ono differs from claims 17-18 in that he does not specifically teach the following: processing means are capable of effecting their determination in accordance with geographical location information of the calling and/or called users, and the topology of at least one communication network in which the communication takes place, where the geographical location constitutes an auxiliary criterion, memory is capable of storing user identifiers in correspondence with information representing a geographical location.

However, Thornton discloses apparatus for voice over IP (VOIP) telephony gateway and methods for use therein which teaches the following: processing means (reads on gateway) are capable of effecting their determination in accordance with geographical location information (for example long distance callers) of the calling and/or called users, and the topology of at least one communication network (internet or PSTN) in which the communication takes place, where the geographical location constitutes an auxiliary criterion, memory is capable of storing user identifiers in correspondence with information representing a geographical location (col. 6, line 61 – col. 7, line 6).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ono's system to provide for the following: processing means are capable of effecting their determination in accordance with geographical location information of the calling and/or called users, and the topology of at least one communication network in which the communication takes place, where the

geographical location constitutes an auxiliary criterion, memory is capable of storing user identifiers in correspondence with information representing a geographical location as this arrangement would provide means for selecting call connection type depending upon geographical location of callers and also provides cost savings for long distance calls as taught by Thornton.

11. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono in view of Khue (US PAT: 6,470,008).

Ono differs from claims 19-20 in that he does not teach the following: processing means are capable of effecting determination in accordance with connection resource availability of at least one communication network in which the communication must take place, constituting an auxiliary criterion, the processing system are arranged to transmit to the calling user data which are representative of the medium determined for the call.

However, Khue discloses interne5 routing system which teaches the following: processing means are capable of effecting determination in accordance with connection resource availability (for example availability of gateways to effect communalization) of at least one communication network in which the communication must take place, constituting an auxiliary criterion, the processing system are arranged to transmit to the calling user data which are representative of the medium determined for the call (col. 2 lines 27-38).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ono's system to provide for the following: processing

means are capable of effecting determination in accordance with connection resource availability of at least one communication network in which the communication must take place, constituting an auxiliary criterion, the processing system are arranged to transmit to the calling user data which are representative of the medium determined for the call as this arrangement would facilitate route the call based on the availability of network resources as taught by Khue.

12. Claims 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ono in view of Horvitz.

Ono differs from claims 23-24 in that it does not specifically teach: processing means are arranged to order the establishment in the event of receiving an authorization from the calling user and/or called user, processing means are able to determine another called terminal, and able to establish another call between them to satisfy the request, and/or another communication medium, in the event that it is not possible to establish communication.

However, Horvitz teaches the following: processing means are arranged to order the establishment in the event of receiving an authorization from the calling user and/or called user, processing means are able to determine another called terminal, and able to establish another call between them to satisfy the request, and/or another communication medium, in the event that it is not possible to establish communication (fig. 4, page 24, line 22 – page 25, line 7).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Ono's system to provide for the following: processing

means are arranged to order the establishment in the event of receiving an authorization from the calling user and/or called user, processing means are able to determine another called terminal, and able to establish another call between them to satisfy the request, and/or another communication medium, in the event that it is not possible to establish communication as this arrangement would provide flexibility to set up calls between communication parties depending upon circumstances of communication parties as taught by Horvitz.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

--(6,775,269) to Kaczmarczyk et al. discloses the following: SIP supports five facets of establishing and terminating multi communications: user location (determination of the end system to be used for communication); user capabilities (determination of the media and media parameters to be used); user availability (determination of the willingness of the calling party to engage); call setup ("ringing," establishment of call parameters of both called and calling party); and call handling (including transfer and termination of calls; col. 5 lines 19-26).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Melur Ramakrishnaiah/
Primary Examiner, Art Unit 2614

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